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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK A. STEVENS

Appeal 2009-005173
Application 09/766,335
Technology Center 2100

Decided: June 29, 2010

Before JAMES D. THOMAS, LEE E. BARRETT, and
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 4-20, and 22-38, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellant's invention relates to a translator, system, and method of translation for translating a source file in a source format to a target file in a target format. A feature identifier determines a feature set of the source file, and a feature writer writes the feature set into the target file in the target format. Abstract.

Representative Claim

20. A method of translating a file from a source format to a target format, the method comprising:

(a) identifying a feature set of a source file;

(b) assembling the feature set in a buffer; and

(c) writing the feature set into a target file in the target format.

Examiner's Rejections

Claims 1, 4-20, and 22-38 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Grobler (US 2002/0052893 A1).

FINDINGS OF FACT

Grobler describes a method for importing table data from a selected source document into a selected target document. Abstract.

A user may select a source and a target using a mouse or keyboard. ¶ [0062]. The source data is temporarily stored, after which the table structure of the temporarily stored source data is analyzed. The source data is parsed for tags, which indicate the table structure of the source data. The

parsing identifies the columns and rows contained in the source data, as well as the contents of the columns and rows. ¶ [0064]; Fig. 8. A target table is created, structured in accordance with the parsing results, and populated with the source data. ¶¶ [0070] - [0072].

PRINCIPLES OF LAW

The *claims* measure the invention. *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc).

"Giving claims their broadest reasonable construction 'serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.'" *In re Amer. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984)). "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process." *Zletz*, 893 F.2d at 322. "Construing claims broadly during prosecution is not unfair to the applicant . . . because the applicant has the opportunity to amend the

claims to obtain more precise claim coverage." *American Academy,* 367 F.3d at 1364.

ANALYSIS

Appellant argues claim 20 as representative. Accordingly, we will decide the appeal on the basis of claim 20 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant contends that the Examiner errs in finding claim 20 to be anticipated by Grobler. Appellant submits that the claim distinguishes over the reference because Grobler moves source data into temporary storage and then analyzes for tags. Appellant argues that claim 20 requires that identifying of the feature set in the source file is done prior to the source file being moved into a buffer. In addition, Appellant goes so far in the Reply Brief as to allege that the "source file" of claim 20 designates a first memory location and the assembling step designates a buffer that is distinct from the first memory location.

Claim 20, however, is silent with respect to where the source file may be. We are thus not persuaded that the claim requires that the source file reside in some memory location different from the buffer.

In response to the Examiner's position that claim 20 does not require identifying a feature set of a source file and only then assembling the feature set in a buffer, Appellant acknowledges that the ordinary rule of construction for method claims does not require that steps be performed in the order in which they are written. However, Appellant argues that the assembling step makes an antecedent reference to "the feature set." Appellant also argues

that the features must be first identified before being regarded as belonging to a set.

Unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one. *Interactive Gift Express, Inc. v. CompuServe, Inc.*, 256 F.3d 1323, 1342 (Fed. Cir. 2001). However, such a result can ensue when the method steps implicitly require that they be performed in the order written. *Id.* (citations omitted).

In this case, we consider the recitation of assembling "the feature set" as requiring that the feature set of the first-recited step is the same "feature set" that is assembled in the second-recited step. As such, the antecedent reference represents no more than a formality (i.e., antecedent basis) rather than a requirement that the first-recited step must occur before the second-recited step. We are also not persuaded that logic requires that the second-recited step can only occur after the first step. The first-recited step recites "identifying" a feature set, but the second-recited step of "assembling" the feature set in a buffer does not require that the feature set first be "identified." In the terms of claim 20, the same "feature set" is identified and assembled in a buffer, but the claim does not require that the "feature set" exist only after "identifying" the "feature set." The feature set of a source file may exist regardless of whether there is an "identifying" of the feature set, and further be unchanged by any "identifying" of the feature set.

We have considered all of Appellant's arguments in the briefs but are not persuaded that claim 20 has been rejected in error. We therefore sustain the § 102(e) rejection of the claims over Grobler.

DECISION

The rejection of claims 1, 4-20, and 22-38 under 35 U.S.C. § 102(e) as being anticipated by Grobler is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

msc

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